REMARKS

I. Amendment to the Specification

Page 5, line 16 of the Specification has been amended to include the U.S. equivalent of originally recited WO99/24080. See Section IV below for further remarks. No new matter is being added by the present amendment to the Specification.

II. Amendment to the Claims

Original claims 1-12 have been cancelled. New claims 13-18 have been added. Support for the new claims can be found in the claims and Specification as originally filed including, for example, p. 9, lns. 11-31 and Figure 2. No new matter is added by the present amendment to the claims.

III. Rejection under 35 USC 112, first paragraph

Claims 1 and 3-6 stand rejected under 35 USC 112, first paragraph as failing to comply with the written description requirement. Specifically, the Examiner contends that the Specification provides no written description for the hydrogenatable, unsaturated substrate compound recited in the claims. Applicants respectfully disagree.

As set forth in MPEP 2163:

> The written description requirement has several policy objectives. "[T]he 'essential goal' of the description of the invention requirement is to clearly convey the information that an applicant has invented the subject matter which is claimed." In re Barker, 559 F.2d 588, 592 n.4, 194 USPQ 470, 473 n.4 (CCPA 1977). Another objective is to put the public in possession of what the applicant claims as the invention. See Regents of the University of California v. Eli Lilly, 119 F.3d 1559, 1566, 43 USPQ2d 1398, 1404 (Fed. Cir. 1997), cert. denied, 523 U.S. 1089 (1998). *>"The 'written description' requirement implements the principle that a patent must describe the technology that is sought to be patented; the requirement serves both to satisfy the inventor's obligation to disclose the technologic knowledge upon which the patent is based, and to demonstrate that the patentee was in possession of the invention that is claimed." Capon v. Eshhar, 418 F.3d 1349, 1357, 76 USPQ2d 1078, 1084 (Fed. Cir. 2005).

In the present application, Applicants have provided the written description support required for the claimed invention including the "hydrogenatable, unsaturated substrate compound" recited in the claims.

As set forth in the Specification:

> The hydrogenatable substrate used may be a material such as a para-hydrogenation substrate as discussed in WO 99/24080. For *in vitro* or *in vivo* MR studies of biological or quasi-biological processes or synthetic polymer (e.g. peptide, polynucleic acid etc.) syntheses, the substrate is preferably hydrogenatable to form a molecule participating in such reactions, e.g. an amino acid, a nucleic acid, a receptor-binding molecule, etc., either a natural such molecule or an analog. (Specification, page 5, lns. 15-20)

In the context of the claimed invention, one of skill in the art would understand what is meant by a "hydrogenatable, unsaturated substrate compound" as the terms "hydrogenatable" and "unsaturated" are known terms in the art. Furthermore, the Specification references published document WO99/24080 and its U.S. equivalent, U.S. Patent 6,574,495, for examples of suitable hydrogenatable, unsaturated substrate compounds.

The Specification as written describes the technology for which protection is being sought and demonstrates that Applicants had possession of the claimed invention. The written description requirement has been met. Applicants respectfully request this rejection be withdrawn.

IV. Objection under 35 USC §132(a)

The amendment to the Specification made on 2/10/2009 is objected to as introducing new matter. Applicants respectfully disagree and believe this objection has been rendered moot by the present amendment. As set forth in MPEP 2163.07, "[m]ere rephrasing of a passage does not constitute new matter. Accordingly, a rewording of a passage where the same meaning remains intact is permissible. *In re Anderson*, 471 F.2d 1237, 176 USPQ 331 (CCPA 1973)." U.S. Patent No. 6,574,495 is the U.S. equivalent of WO99/24080. Hence no new matter is being added as the amendment is merely an alternative means of describing WO99/24080. Applicants respectfully request this objection be withdrawn.

V. Rejection Under 35 U.S.C. §102(b)

Claims 1 and 3-6 stand rejected under 35 U.S.C. §102(b) as being anticipated by Axelsson *et al.*, US 6,872,380. Applicants respectfully disagree.

Applicants' claimed invention as set forth in new claims 13-18 is directed to a method for producing an MR contrast agent whereby a hydrogenated contrast agent is exposed to a series of magnetic field pulses of a certain magnetic field strength, orientation and duration wherein any one magnetic pulse has an orientation different from the pulse prior; and wherein the final pulse, optionally, has the same orientation as the initial pulse. Axelsson fails to teach or suggest the application of a series of magnetic field pulses where each pulse has a different orientation to the pulse prior; thus Axelsson fails to teach or suggest a recited element of Applicants' claimed invention. Thus Applicants' claimed invention is novel over Axelsson. Applicants respectfully request this rejection be withdrawn.

VI. Double Patenting Rejection

Claims 1 and 3-6 stand provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over the claims of copending Application No. 10/526,240. Applicants respectfully traverse this rejection.

For reasons given in Section V above, co-pending application no 10/526,240 fails to teach of suggest Applicants' claimed invention since the co-pending application fails to teach or suggest the application of a series of magnetic field pulses of differing orientations in the manner recited in the claims. Thus, Applicants' claimed invention is not obvious in view of co-pending application no. 10/526,240. Applicants respectfully request this rejection be withdrawn.

VII. Conclusion

In view of the amendments and remarks hereinabove, Applicants respectfully submit that the instant application in condition for allowance. Favorable action thereon is respectfully requested.

Any questions with respect to the foregoing may be directed to Applicants' undersigned counsel at the telephone number below.

The Commissioner is hereby authorized to charge any additional fees which may be required, or credit any overpayment, in connection with this Response to Deposit Account No. 502-665 in the name of GE Healthcare, Inc.

Respectfully submitted,

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